Office Supreme Court, U.S.
FILED
27 1963
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

No. 322

ALEXANDER T. SPERRY, *Petitioner*,

v.

STATE OF FLORIDA, *ex rel.*, THE FLORIDA BAR,
Respondent.

On Writ of Certiorari to the Supreme Court of Florida

BRIEF OF AMERICAN CHEMICAL SOCIETY AS AMICUS CURIAE

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INTEREST OF AMICUS CURIAE

The American Chemical Society is a scientific and educational organization chartered by Act of Congress approved August 25, 1937, Public Law No. 358, Chapter 762, 75th Congress, 1st Session. The Society's membership consists of more than 95,000 chemists and chemical engineers of whom some 90,000 are residents of the United States.

More than 40 per cent of the Society's members hold doctorate degrees and an additional 20 per cent have received master's degrees in the various fields of chemistry. Nearly two-thirds of the Society's members engage in research which ultimately results in the creation of patentable inventions. Each of these persons is a potential investor and many of them have been issued United States patents. In fact, these persons were responsible in part for the 10,000 chemical patents issued by the United States Patent Office in 1961 and the 11,767 chemical patents issued in 1962.

The Society's membership is vitally interested in the basic issue herein, namely: Whether the State of Florida in the exercise of its police power may prohibit the performance of specified activities within the State by a non-lawyer who has been expressly authorized by the United States to engage in such activities?

This *Amicus* has a broad interest in matters affecting patents, especially those which are chemical in nature.[1] It is interesting to note that approximately 21 per cent of all United States patents issued in 1961 (10,000 of 48,000) and in 1962 (11,767 of 55,691) were so-called chemical patents, which reflects an increase in 1962 over 1961 of 17.67 per cent in chemical patents as contrasted with an increase of about 16.02 per cent in the total number of patents issued.

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[1] The Chemical Abstracts Service, operated by the Society at Ohio State University, Columbus, Ohio, identifies, abstracts, and indexes all new chemical patents published throughout the world. For the past 55 years the Chemical Abstracts Service has been the sole source for the abstracting and indexing of chemical patents originating in 24 foreign countries, including some behind the Iron Curtain.

Surveys conducted by the Society indicate that not less than 1,000 of the 7,232 persons registered[2] to represent applicants before the Patent Office are members of the American Chemical Society.

The membership of the Society is concerned over the consequences of a decision by this Court which would sustain the power of Florida to prohibit the United States Patent Office practitioner herein from engaging in conduct which is authorized by the United States in admitting him to practice before the Patent Office. Also of concern to the Society is the impact a decision of the Court adverse to the Petitioner could have upon the maintenance of current relationships between inventors in chemistry, members of the Society, and non-lawyer patent agents, and upon the fruits of the technical and scientific interchange presently existing among them.

ARGUMENT

In the interest of brevity this *Amicus* endorses generally the arguments set forth in the Brief of Petitioner Alexander P. Sperry.

REGULATION OF PATENT OFFICE PRACTITIONERS BY FEDERAL AUTHORITY NULLIFIES ANY ATTEMPTED REGULATION BY THE STATE OF FLORIDA WHICH IS INCONSISTENT OR IN CONFLICT THEREWITH

Pre-emption of a particular field of legislation or regulation by the Federal Government is not lightly to be inferred. Where possible this Court should seek to find a permissible accommodation that citizens may be subject to reasonable regulation by both State and Federal authority. Yet, it must be recognized that in

[2] Brief For The Petitioner, p. 4.

those areas where accommodation is not possible and Federal power over the subject matter is supreme, the several States are without power to impose legislation or regulation which is inconsistent with existing Federal regulation. *McCulloch* v. *Maryland*, 4 Wheat. 316, 4 L. Ed. 314 (1819).

In the present case there can be no question that the Federal power is paramount with regard to the adoption of a national patent system and the regulation of all matters pertaining to practice before the United States Patent Office. Pursuant to Constitutional grant,[3] as implemented by Congressional enactment[4] and the administrative regulations of the Commissioner of Patents,[5] the Federal Government has undertaken the regulation of "agents, attorneys, or other persons representing applicants or other parties before the Patent Office * * *".[6] Registered patent agents who are not attorneys-at-law are authorized to represent applicants in the preparation and prosecution of applications for United States patents. The exercise of the authority granted to such practitioners necessarily includes the right to engage in the consideration of documents affecting patents, the formation of opinions, and the rendering of advice[7] regarding the patentability of inventions.

Notwithstanding the provision of such authorization by the United States, the State of Florida has decreed

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[3] Constitution of the United States, Art. I Sec. 8, Cl. 8.

[4] Act of July 19, 1952, 66 Stat. 795-796, 35 U.S.C. Sections 31-33.

[5] Rules of Practice of the United States Patent Office in Patent Cases, 37 C.F.R. Sections 1.1-1.352.

[6] Act of July 19, 1952, 66 Stat. 795, 35 U.S.C. Section 31.

[7] *Ibid.*

that Petitioner may not engage in such conduct unless and until he becomes an attorney and member of the Florida Bar.

Nowhere in the record are facts suggesting the Petitioner engaged in the unauthorized practice of law by appearing before forums in the State of Florida, nor does the record indicate that Petitioner has rendered opinions as to the patentability or infringement on patent rights, or prepared, drafted and construed documents, other than in the preparation and prosecution of applications for letters patent, and amendments thereto. The State of Florida through the court below, however, has decided that such record shows Petitioner has engaged in the unauthorized practice of law in Florida and thereby settled the question as a matter of state law.

The present state of the record, therefore, presents a clear conflict between Federal and State power regarding subject matter clearly set apart as national in scope and interest and does not permit of the exercise of both such powers. Accordingly, the attempted regulation of the qualifications of United States Patent Office practitioners by the State of Florida should be declared a nullity. *Battelle Memorial Institute* v. *Green*, 133 U.S.P.Q. 49 (Ohio Ct. App., 1962) (unreported);[5] *Rice* v. *Santa Fe Elevator Corporation*, 331 U.S. 218, 91 L. Ed. 1447 (1947).

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[5] Decided February 13, 1962 by the Ohio Court of Appeals for Franklin County. The case is now in the Supreme Court of Ohio for review but has not been assigned, pending final judgment by this Court as to Petitioner Alexander T. Sperry.

CONCLUSION

For the reasons stated herein, and in the Brief of Petitioner Alexander T. Sperry, the decision of the court below should be reversed to permit Petitioner in the State of Florida "to represent applicants before the Patent Office in the preparation and prosecution of applications for patent,", a right granted him by the Commissioner of Patents pursuant to the authorization of Congress.

Respectfully submitted,

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